

In re Appln. of Hermann Schmodde et al.
Application No. 10/030,790

REMARKS

Applicants have carefully reviewed and considered the Office Action dated July 24, 2004 and the references cited therein. Claims 16-25 have been cancelled and claim 41 has been amended to improve its form. Claims 26-32 and 35-48 are presently pending in this application with claims 26-32 and 35-40 having been allowed. Applicants believe that the application is now in condition for allowance. Accordingly, favorable reconsideration in light of the foregoing amendments and the following remarks is respectfully requested.

Claims 41-43 and 45-47 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,716,024 ("the Kaufmann patent") in view of U.S. Patent 4,290,565 ("the Smith patent"). Claims 44 and 48 stand rejected under § 103 as unpatentable over the Kaufmann patent in view of the Smith patent further in view of U.S. Patent 4,290,565 ("the Horvath patent"). According to the Examiner, the Smith patent teaches the grounding of a metallic guide element to the frame of the machine to prevent build-up of wax and lint. The Examiner further asserts that it would have been obvious to provide the yarn supplying device of the Kaufmann patent with a grounding means for a metallic guide element in contact with the yarn as taught by the Smith patent.

Applicants respectfully submit that the combination of the Kaufmann and Smith patents is not well taken and in any event does not yield the invention recited in independent claims 41 and 45. The Kaufmann patent discloses a yarn supplying device. However, as acknowledged by the Examiner, the Kaufmann patent does not teach an electrically grounded conductor arranged in the housing and connected to an element in contact with yarn. The Smith patent discloses a yarn tension device that includes a plurality of metallic cups 21 that are welded to a metallic bar 17. A tension ball is arranged in the interior chamber of each of the metallic cups. A retaining wire strand is used to retain the tension balls in the cups. According to the Smith patent, this retaining wire strand can also act as a yarn guide, if the yarn does not feed in axial alignment from the cup.

Initially, there is no reason why one skilled in the art would be motivated to take a retaining wire strand from a tension device and use it in a yarn supply device such as disclosed in the Kaufmann patent. The wire strand of the Smith device is primarily used to retain a tension ball in a cup. The Kaufmann device does not include tension cups or tension balls. Thus, there is no reason why someone looking to modify the Kaufmann yarn supplying device would look to the wire strand of the Smith tension device. The purported motivation cited by the Examiner is "to prevent lint from accumulating." Significantly, however, the Smith tension device relies on the metal to metal grounding effect produced by having metallic cups arranged on a metallic bar for dissipating any static electricity built-up by the

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yarn passing through the tension device. (See col. 4, lines 9-17). In other words, the Smith tension device relies on its *metal housing* to dissipate static electricity.

Clearly, one looking to the Smith patent to solve a problem with the accumulation of lint on the Kaufmann yarn supplying device would be taught to make the housing of the Kaufmann device metal. To the extent that the Kaufmann and Smith patents are combinable, the only rational result would involve making the housing of the Kaufmann yarn supplying device out of metal. Thus, even if the Kaufmann and Smith patents were combined, the resulting yarn supplying device would not meet all the limitations of the claims, which specifically include a housing made of metal. The only way the invention recited in independent claims 41 and 45 would result from the Kaufmann and Smith patents is if improper hindsight were used. Accordingly, independent claims 41 and 45 and the claims depending therefrom are allowable over the Kaufmann and Smith patents.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Amendment or ROA - Regular (Revised 7/29/03)